



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20531
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,257	01/09/2001	Wolfgang Gunther	201013US0PCT	8345

22850 7590 01/08/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MEDLEY, MARGARET B

ART UNIT PAPER NUMBER

1714

8

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,257

Applicant(s)

GUNTHER ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1714

DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

ek In claim 1 the phrase "n is... 14 to 18" is considered as new matter. The disclosure at pages 9-10 that "n is 12-18, 14-17, 14-16 and 15"; and at page 14 Table I that "n is 10, 15, 20, 25, 30"; and at page 15 Table II that "n is 14, 25" do not explicitly support that "n is 14-18" of amended claim 1. Claim 1 is further effect, of at least one propoxylate of formula I". The claim does not provide for the additive combination comprising (i) propoxylate additive and (ii) at least one detergent additive as set forth on page 4, lines 12-23 of the instant application which appears to be in conflict with applicants references to page 4, lines 14-16.

Claims 3, 5, 9 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase that "n is ... 14 to 18" is considered as new matter. The disclosure at pages 9-10 that "n is 12-18, particularly 14-17, especially 14-16 and particularly 15", and the disclosure at

Art Unit: 1714

Table I of page 14 that "n is 10, 15, 20, 30" and the disclosure at Table II of page 15 that "n is 15, 25" do not explicitly support that "n is 14-18" of amended claim 3.

Claims 10-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase that "n is ... 14 to 18" is considered as new matter because the disclosure at pages 9-10 that "n is 12-18, particularly 14-17, especially 14-16, and particularly 15", and the disclosure at Table I of page 14 that "n is 10, 15, 20, 30" and the disclosure at Table II of page 15 that "n is 15, 25" do not explicitly support that "n is 14-18" of amended claim 10.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase that "n is 14 to 18" is considered as new matter because the disclosure at pages 9-10 that "n is 12-18, particularly 14-17, especially 14-16 and particularly 15, and the disclosure at Table I of page 14 that "n is 10, 15, 20, 30" and the disclosure at Table II of page 1 that "n is 15, 25" do not explicitly support that "n is 14-18" of amended claim 13.

Claims 14-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

Art Unit: 1714

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase that "n is ... 14 to 18" is considered as new matter because the disclosure at pages 9-10 that "n is 12-18, particularly 14-17, especially 14-16 and particularly 15", and at Table I of page 14 that "n is 10, 15, 20, 30" and at Table II of page 15 that "n is 15, 25" do not explicitly support that "n is 14-18" of amended claim 14.

Claims 10-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling.

A fuel additive mixture which contains i) propoxylate of formula (I) and ii) of detergent formula (II) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure referenced by applicants at page 4, lines 16+ demonstrates that applicants considered said features essential, is not reflected in the claims, which are rejected.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. A fuel additive mixture concentrate comprising i) propoxylated of formula (I) and ii) detergent of formula II, and a solvent or diluents, and optional further conventional additives are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure referenced by applicants at page 4, lines 16+ and the disclosure at lines 19-20 of page 12

Art Unit: 1714

demonstrates that applicants considered said features essential, is not reflected in the claims, which are rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3, 5-8 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For clarity the article —and— should be inserted in claim 3, after formula (I) in line 3 after "alkenyl;" and after formula (II) in line 2 after "5000;".

Claims 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 appears to duplicate claim 10 and does not provide a further limitation of the claimed invention because each claim is directed to an additive of formula I. Claim 10 is further indefinite and confusing in that it specifically requires only the presence of compound of formula I, which is in conflict with line 1 of the claim requiring the presence of a mixture. Claim 13 requires or eludes to the requirement of a concentrate of the additive of formula I and also elude too a solvent or diluents that produces that produces a concentrate. Also, claim 13 is confusing in that it is unclear as to the intended fuel additive mixture.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8 and 10-15 for reasons made of record in Paper No. 5 dated March 14, 2002 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thomas EPO-704,519A1.

Claims 1-3, 5-8 and 10-15 for reasons made of record in Paper No. 5 dated March 14, 2002 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Daly EPO 878,532 A1.

Claims 1, 2 and 9 for reasons made of record in Paper No. 5 dated March 14, 2002 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Polss 3,901,665.

Claims 1-3, 5-6, 10, 13-15 for reasons made of record in Paper No. 5 dated March 15, 2002 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Aiello et al (Aiello) 5,006, 130.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9 and 16 for reasons made of record in Paper No. 5 dated March 14, 2002 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas EP 0704,519A1.

Applicant's arguments filed September 16, 2002 have been fully considered but they are not persuasive.

Applicant argues that Thomas fails to disclose an amount, having an intake system cleaning effect, of the recited propoxylate additive of the formula I in which n is an integer of from 14 to 18.

The argument by applicant is refuted by the teachings of Thomas discussed at the bottom of page 3 of Paper No. 5 dated March 14, 2002. Thomas teaches an intake valve cleaner additive for fuel composition in ICE is known, page 4, lines 28-30 and teachings to (i) propoxylate to additive of formula I where n is 8-30 and R' include iso-tridecanol, page 3, lines 41-46. These teachings clearly overlap the newly added claimed range that "n is from 14-18". It is further noted that the said newly claimed range has been deemed to contain new matter.

Applicant further argues that Table 1 at page 14 of the instant specification rebuts the 103 prima facie rejection of claim 9. The examiner takes the position that Table I at page 14 of the instant specification only shows results with their additives

versa the absence of their additives. The Table does not show any results with the use of the additives of Thomas and therefore cannot be used as evidence to rebut the 103 rejection of record.

Applicant argues that Daly fails to disclose all of the limitation of the claimed invention and should be withdrawn.

The teachings of Daley are explicitly set forth at the top of page 4 of Paper No. 5 dated March 4, 2002 wherein the propoxylated additive and a detergent in amounts of 100-10,000 are used to prevent or reduce the formation of intake valve deposits in an engine. Further the examiner deemed the newly amended claims to contain new matter.

Applicants argues that Polss fails to exemplify the recited propoxylate additive of the formula I in which "n is 14-18" and fail to suggest the intake system cleaning effect.

The teachings of Polss are set forth in the middle of page 5 of Paper No. 5 dated March 14, 2002. The teachings provide for a propoxylate wherein n is 4-20 and R' is 10-20. The claimed range overlaps the newly amended claims range along with a detergent additive. The detergent additive is known as valve cleaner additive, note column 1, lines 57-61. Further the newly amended claims are deemed to contain new matter.

Applicant argues that Aiello is directed to a different technical problem than the present invention and fail to disclose the specific propoxylate additive of the instant claimed invention.

The teachings of Aiello is set forth in the bridging paragraph of pages 4-5 of Paper No. 5 dated March 14, 2002 directed to propoxylate wherein n is at least 7 and R' is up to 20 carbon atoms in an amount of 80-110 ppm along with a detergent. The detergent additive is a known valve cleanser. The newly amended claims are deemed to contain new subject matter.

It is further noted that applicants have relied on the data presented in Table I, page 14, directed to tridecanol (R' is 13) and n is 10, 15, 20, 25 and 30 alone in the amount is 400 mg/kg; and Table II page 15 directed to tridecanol (R' is 13) and n is 15, 25 in combination with PIBA detergent in a 1:1 ratio and the total amount is 500 mg/kg. It appears that the newly amended claims are much broader in scope than the data presented in Table I and II to show unexpected results.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1714

Any inquiry concerning this communication from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can generally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh
January 7, 2003


MARGARET MEDLEY
PRIMARY EXAMINER